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Michael B. Stewart Rader, Fishman & Grauer PLLC 39533 Woodward Avenue, Suite 140 Bloomfield Hills, MI 48304			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/835,206	BENNETT ET AL
	<b>Examiner</b>	<b>Art Unit</b>
	Jean D Janvier	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 April 2001.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-29 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .	6) <input type="checkbox"/> Other: _____ .

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I.     Claims 1-24, drawn to a method and system for sending to a registered recipient by a processing facility or clearinghouse a targeted e-mail from a merchant having printed therein an advertising message related to the merchant and for providing a reward to the responding recipient, classified in 705/14, 705/26.
  
- II.    Claims 25-29, drawn to a method and system for sending to a registered recipient by a processing facility or clearinghouse a targeted e-mail from a merchant having printed therein an advertising message related to the merchant, for providing a reward to the responding recipient and for maintaining a profile for each recipient  
**that each recipient or participating patron can read and modify.**

Here Inventions II, filed in a single Application, and I are related as combination/subcombination separately usable for the reason noted above in bold face. No linking claim(s) is present.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed Invention for prosecution on the merits to which the claims shall be restricted. **Applicant has indeed elected, with traverse, over the phone to have Invention I examined.**

## **DETAILED ACTION**

### *Specification*

The title of the invention, under 37 C.F.R 1.72, should be descriptive, brief and technically accurate.

### *Claim Status*

Claims 1-29 were originally presented for prosecution. After a restriction requirement, Applicant has elected with traverse to have claims 1-24 examined. Hence, claims 1-24 are herein being examined.

### *Claim Objections*

Claims 3 and 17 are objected to because of the following informalities:

Regarding claim 3 "...wherein said clearinghouse facilitates the exchange of patron information between different merchants" appears to be broad and will be interpreted as -- ...wherein said clearinghouse facilitates the delivery of e-mail messages from different merchants to the patrons and the patrons' replies or responses to incoming e-mail messages--.

Concerning claim 17, line 2, "... least..." should apparently be --..., at least...--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the

invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Concerning claim 18, the limitations "...wherein data in said unit is communicated to said clearinghouse on a periodic basis using one of a **manual transfer** of information and a

direct electronic connection." The phrase "...manual transfer ..." renders the claim non-statutory. In other words, if the transfer is a manual transfer, then the claim is not in the technological art. Deleting this language from the claim renders the claim statutory.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2-6 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamakura et al. (hereinafter Karakura), US Patent 6,076,101.

As per claim 1, Karakura discloses a system for distributing by a third party or processing or clearinghouse targeted e-mails having incorporated therein senders' or merchants' promotional messages and bonus points or electronic communications to qualified and registered recipients or patrons from registered senders or companies or merchants (recipients or participating patrons providing e-mail addresses to processing facility or clearinghouse during a registration process), wherein a registered patron is encouraged to reply to a targeted e-mail message sent from an identified merchant or company and earn bonus points. An original e-mail sent from at least one registered merchant or company via a merchant terminal is stored in an

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outgoing message storage unit or database coupled to a host computer or file server at a processing facility or clearinghouse. An outgoing mail registration unit (a registration database file) storing a list (a subset) of registered recipients or patrons to whom the targeted e-mail should be delivered and information regarding bonus points or electronic communications that should be credited to responding patrons, thereby inducing them to read the targeted e-mail as intended by the merchant. Further, the system or the processing facility keeps track of the number of points or bonus points accumulated by each registered and responding recipient or patron and notifies a recipient or patron when his accumulated points reach a predetermined threshold and wherein the accumulated points can be utilized to purchase a particular gift or product (See abstract; figs. 1-11; col. 1: 56 to col. 2: 13; col. 9: 10 to col. 10: 32; see claims 1-11 of the present reference).

As per claims 2-6, 9, 10, 11 and 12, Karakura discloses a system for distributing by a third party or processing or clearinghouse targeted e-mails having incorporated therein senders' or merchants' promotional messages and bonus points or electronic communications to qualified and registered recipients or patrons from registered senders or companies or merchants (recipients or participating patrons providing e-mail addresses to processing facility or clearinghouse during a registration process), wherein a registered patron (having a unique recipient ID or account) is encouraged to reply to a targeted e-mail message sent from an identified merchant or company (having a unique merchant ID or account) and earn bonus points. An original e-mail sent from at least one registered merchant or company via a merchant terminal 1a-1b of fig. 1 is received and stored in an outgoing message storage unit or database

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coupled to a host computer or file server 2 of fig. 2 at a processing facility or clearinghouse. An outgoing mail registration unit (a registration database file) storing a list (a subset) of registered recipients or patrons to whom the targeted e-mail should be delivered (based on the patrons' profile and categories of topics) and information regarding bonus points or electronic communications that should be credited to responding patrons replying to the e-mail using terminals 3a-3b of fig. 1 connected to a communication network 4, thereby inducing them to read the targeted e-mail as intended by the merchant. In other words, targeted e-mail messages from specific registered merchants or senders are delivered to a subset or a list of registered patrons or recipients according to the patrons' profile matching the profile of the specific merchants (matching a subset of merchants with a subset of patrons based on mutual interests). Further, the system or the processing facility keeps track of the number of points or bonus points accumulated by each registered and responding recipient or patron and notifies a recipient or patron when his accumulated points reach a predetermined threshold and wherein the accumulated points can be utilized to purchase a particular gift or product (See abstract; figs. 1-11; col. 1: 56 to col. 2: 13; col. 9: 10 to col. 10: 32; col. 4: 38-51; see claims 1-11 of the present reference).

In addition, the system or processing facility monitors the patrons comments or responses to a particular e-mail so as to determine whether a patron is a first-time respondent to any e-mail communication and if the patron is a first-time respondent, then a file is created for the patron (an entry table is created), which stores the points earned by the patron for responding or replying to the e-mail. On the other hand, if the responding recipient is a regular, then the number of stored points already accumulated in his file is updated. The system also tracks the

number of lines in the patron's response or reply and issues points or bonus points to the patron based on the number of lines included in the reply. The processing facility also allows the patron to reply to the same e-mail in more than one occasions and monitors each reply to make sure that the information printed in a subsequent or second reply is unique or different from the information associated with a previous reply to the same e-mail communication, thereby preventing fraud while rendering the system more effective (col. 7: 17 to col. 9: 9). It is further understood that the e-mail communication is sent out to the patron, on a periodic basis or during an advertising or promotional campaign conducted on behalf of the merchant or company by the processing facility or clearinghouse, based on the patron's profile.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8, 13, 14-16, 17, 18 and 19-24 are rejected under 35 USC 103(a) as being unpatentable over Kamakura.

As per claims 7, 14-15, 18, 19, 20 and 22-24, Karakura discloses a system for distributing by a third party or processing or clearinghouse targeted e-mails having incorporated therein senders' or merchants' promotional messages and bonus points or electronic communications to qualified and registered recipients or patrons from registered senders or companies or merchants (recipients or participating patrons providing e-mail addresses to processing facility or clearinghouse during a registration process), wherein a registered patron (having a unique recipient ID or account or identifier or code used to reply to e-mail messages from a plurality of merchants associated with the processing facility or clearinghouse) is encouraged to reply to a targeted e-mail message sent from an identified merchant or company (having a unique merchant ID or account) and earn bonus points. An original e-mail sent from at least one registered merchant or company via a merchant terminal 1a-1b of fig. 1 is received and stored in an outgoing message storage unit or database coupled to a host computer or file server 2 of fig. 2 at a processing facility or clearinghouse (the registered merchant sends e-mail messages or data via terminal 1a-1b or physical unit to the processing facility or center on a periodic basis or during a special promotional campaign, as practiced in the industry). An outgoing mail registration unit (a registration database file) storing a list (a subset) of registered recipients or patrons to whom the targeted e-mail should be delivered (based on the patrons' profile and categories of topics) and information regarding bonus points or electronic communications that should be credited to

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responding patrons replying to the e-mail using terminals 3a-3b of fig. 1 connected to a communication network 4, thereby inducing them to read the targeted e-mail as intended by the merchant. In other words, targeted e-mail messages from specific registered merchants or senders are delivered to a subset or a list of registered patrons or recipients according to the patrons' profile matching the profile of the specific merchants (matching a subset of merchants with a subset of patrons based on mutual interests). Further, the system or the processing facility keeps track of the number of points or bonus points accumulated by each registered and responding recipient or patron and notifies a recipient or patron when his accumulated points reach a predetermined threshold and wherein the accumulated points can be utilized to purchase a particular gift or product (See abstract; figs. 1-11; col. 1: 56 to col. 2: 13; col. 9: 10 to col. 10: 32; col. 4: 38-51; see claims 1-11 of the present reference).

In addition, the system or processing facility monitors the patrons comments or responses to a particular e-mail so as to determine whether a patron is a first-time respondent to any e-mail communication and if the patron is a first-time respondent, then a file is created for the patron (an entry table is created), which stores the points earned by the patron for responding or replying to the e-mail. On the other hand, if the responding recipient is a regular, then the number of stored points already accumulated in his file is updated. The system also tracks the number of lines in the patron's response or reply and issues points or bonus points to the patron based on the number of lines included in the reply. The processing facility also allows the patron to reply to the same e-mail in more than one occasions and monitors each reply to make sure that the information printed in a subsequent or second reply is unique or different from the information associated with a previous reply to the same e-mail communication, thereby

preventing fraud while rendering the system more effective (col. 7: 17 to col. 9: 9). It is further understood that the e-mail communication is sent out to the patron, on a periodic basis or during an advertising or promotional campaign conducted on behalf of the merchant or company by the processing facility or clearinghouse, based on the patron's profile.

As per claims 8, 14, 16, 19 and 21, Kamakura does not explicitly disclose sending to a patron or recipient an e-mail or electronic communication containing a hyperlink, which upon activation allows the patron or the recipient of the e-mail to visit a web page (interface) corresponding to a merchant's unit or sender of the e-mail where the patron can access using an identification device or a patron's terminal 3a-3b of fig. 1 the merchant's unit or terminal 1a-1b to conduct a transaction and wherein information regarding the patron's visit at the merchant's site or web page is stored at the merchant's unit.

However, sending or transmitting a message or advertising message to a customer having printed therein a hyperlink, representative of an advertiser's web site, and upon activating or clicking on the hyperlink the customer can visit the advertiser's web site to obtain more information about an advertised product or a product featured in the advertising message or even purchase the advertised product or service or other products or services and wherein data regarding the transaction or the purchase are stored at the advertiser's system or web server is an old and well established in the art. For example, a business entity or associate's of an advertiser (advertising medium) will send an e-mail (or regular mail) to a customer inviting him to visit the associate's web site and receive product information regarding products of interest to the

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customer and wherein upon clicking on a hyperlink, displayed on the customer's computer screen while visiting the associate's web site and reading or viewing information related to a product of interest, the customer can be transported to another web site or the advertiser's web site where the customer can obtain additional or more detailed information regarding the advertised product or product of interest or even purchase the said product or other products or services and wherein data regarding the transaction or the purchase are stored at the advertiser's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate different associates for successfully referring customers to the advertiser's web site. In another example, Freelotto.com, an Internet site offering free lotto picks to registered customers from a lottery game run and controlled by the site, will send the results of a drawing to a registered customer along with an advertising message including a hyperlink, indicative of the advertiser's web site, via e-mail and upon clicking on the hyperlink printed in the e-mail message, the customer can visit the advertiser's web site where he can receive more information regarding a product or service featured in the advertising message ("Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the above disclosure ("Official Notice") into the e-mail communication of Kamakura so as to send or transmit by a processing facility or clearinghouse an e-mail message, having printed therein an advertising message from a merchant along with a hyperlink representative of the merchant's web site address, to a registered recipient or patron and wherein, upon clicking on the hyperlink displayed in the e-mail

message, the recipient is transported to the merchant's or advertiser's web site where the recipient can receive more detailed information about a product or service featured in the advertising message or even purchase the said product or service or other products or services and the recipient earns bonus points for reading the e-mail and visiting the merchant's web site and wherein data regarding the transaction or the purchase are stored at the advertiser's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or clearinghouse for successfully referring customers to the advertiser's or merchant's web site, thereby allowing a patron or recipient who reads a merchant's advertising message to immediately provide feedback to the merchant or advertiser or sender of the targeted e-mail and earn bonus points when the patron clicks on a hyperlink within the e-mail to visit the merchant's or advertiser's web site to receive more information about a product or service featured in the e-mail or even purchase the said product or service or other products or services sold at the merchant's web site and wherein data regarding the transaction or the purchase are stored at the advertiser's or merchant's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or clearinghouse for successfully referring customers to the advertiser's or merchant's web site, while rendering the system more cost-effective and enabling the merchant to measure the effectiveness of the distribution medium or processing facility in real-time.

As per claim 7, Kamakura does not expressly disclose the steps of verifying an e-mail address provided by a patron or recipient by sending a test e-mail to the patron and saving or storing in a database of the clearinghouse the success of the test.

However, the process of sending a test e-mail to a recipient or patron to thereby verify the accuracy of the recipient's provided e-mail address is a matter of choice or desires, which does not directly or indirectly impact the utility or the functionality of the system by which a patronage e-mail is sent to the registered recipient or patron. Further, when an e-mail or test e-mail is transmitted over a network, such as the Internet, to a recipient's e-mail address, the system does not distinguish between the regular e-mail or test e-mail and if the patron's e-mail address is incorrect, then the system will return an **undeliverable mail notification message** to the originator or sender of the e-mail, regardless of the content of the sent e-mail (regular e-mail or test mail), otherwise the recipient will receive the sent or transmitted e-mail accordingly.

The latter conclusion is well within the skills of an ordinary artisan who would have been motivated at the time of the invention to test e-mail addresses provided by customers during registration at the processing facility or center by sending test or introductory e-mails to these recipients or customers and to quickly detect and dismiss recipients with undeliverable or inaccurate e-mail addresses, thereby guaranteeing that the merchants' or senders' or advertisers' advertising messages embedded or displayed in the e-mail messages are delivered to recipients with correct e-mail addresses, while making sure that the merchants compensate the processing facility or center for e-mail messages, including advertising the merchants' messages, that are properly delivered or transmitted to the targeted recipients with the correct and deliverable e-mail addresses.

As per claim 13, Kamakura does not expressly disclose a merchant or advertiser having a plurality of locations wherein each location has a unique identifier or code.

However, having a merchant or grocer or a retailer or a Supermarket established a plurality of local stores located in different geographic locations wherein each local store has a unique address or a unique identifier uniquely identifying each local store in the merchant's database is an old and well taught in the art. Giant Food, INC., Red Apple, Shoppers, etc., commonly referred to as store chain, are examples of merchants with multiple local stores situated in different geographic locations. No further disclosure is necessary here ("Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the above disclosure ("Official Notice") into the e-mail communication of Kamakura so as to send or transmit by a processing facility or clearinghouse an e-mail message, having printed therein an advertising message from a merchant promoting a product or service available at a local store located in a specific geographic location, to a registered recipient or patron living in a geographic location adjacent to the local store, thereby rendering the e-mail communication more appealing to the recipient by presenting location-sensitive advertising message to the customer or recipient and encouraging the recipient to read or view the merchant's message and eventually purchase the product or service, by using a certain number of accumulated bonus points redeemable on the product or service, featured in the message and sold at a nearby local store, while providing great flexibility and ability to the merchant to effectively advertise the product or service availability at a

particular destination or geographical location, outside the merchant's usual target market, and enabling the advertiser or merchant to target an e-mail recipient based on his geographic location adjacent to a local store or based upon a geographical location of interest to the advertiser or merchant, which in the end increases market share for the product or service at the geographic location of interest.

As per claim 17, although Kamakura discloses a system wherein a notification e-mail message is sent to a registered patron when his total accumulated bonus points reach a preset threshold number so that the recipient can redeem these points for a gift (col. 9: 10-18; col. 9: 33-53), Kamakura does not explicitly teach where the gift is sold, nor does he mention a merchant unit having at least one redemption button displayed thereon, reflecting a redemption offer associated with a responding recipient.

However, using a unit having a reward or redemption button incorporated thereon is old and well established in the art. For example, a customer, member of a reward program, conducting a fuel transaction presses a "reward button" in the interface of the fuel dispenser, the gas station system will automatically dispense fuel for the customer at a discounted price, subsequent to identifying the customer and in accordance with the customer's reward information stored in a remote database ("Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the above disclosure ("Official Notice") into the e-mail communication of Kamakura so as to send or transmit by a processing facility or clearinghouse an e-mail message, having printed therein an advertising message from

a merchant along with a hyperlink representative of the merchant's web site address having displayed thereon a reward or redemption button, to a registered recipient or patron and wherein, upon clicking on the hyperlink displayed in the e-mail message, the recipient is transported to the merchant's or advertiser's web site, having printed thereon a redemption button associated with the identified recipient, where the recipient can receive more detailed information about a product or service featured in the advertising message or even purchase the said product or service or other products or services, upon redeeming certain number of accumulated bonus points, and the recipient further earns award bonus points for reading or responding to the e-mail and visiting the merchant's web site, where he can redeem some of his accumulated points, and wherein data regarding the transaction or the purchase are stored at the advertiser's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or clearinghouse for successfully referring customers to the advertiser's or merchant's web site, thereby encouraging a patron or recipient who reads a merchant's advertising message to immediately provide feedback to the merchant or advertiser or sender of the targeted e-mail and further earn award bonus points when the patron clicks on a hyperlink within the e-mail to visit the merchant's or advertiser's web site to receive more information about a product or service featured in the e-mail or even purchase the said product or service or other products or services sold at the merchant's web site, by redeeming some of his accumulated points, and wherein data regarding the transaction or the purchase are stored at the advertiser's or merchant's system or web server where they are being utilized in further marketing analysis or to further target the customer and to compile accounting report used to compensate the processing facility or

clearinghouse for successfully referring customers to the advertiser's or merchant's web site, while rendering the system more cost-effective and enabling the merchant to measure the effectiveness of the distribution medium or processing facility in real-time.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5, 793, 972A to Shane discloses a system for sending an e-mail message, having printed therein a hyperlink, to a registered recipient and wherein upon activating the hyperlink the recipient can visit his personal web page where he can view customized or personalized promotional messages directed to his attention.

WO 97/23838 to Scroggie teaches an incentive distribution network or system over the Internet wherein a plurality of purchasing incentives and shopping aids are made available for qualified customers through the Internet or via e-mail. A customer (10) of retail stores, logs into the system and then elects to browse among available purchasing offers (18, 22), elects to claim a product rebate or to receive product information. The system merges customer's supplied information (270) with other purchase incentive data (272) and creates a printable graphical image of the purchasing incentive (282) for transmission to the customer. In an alternate embodiment, the purchase incentive is not transmitted directly to the customer. Instead, the terms of the incentive are transmitted electronically to the retail store (310) of fig. 13 designated by

customer (10) or located in the customer's geographical region, who receives either a token (316) having at least a specific code or a bar code to present at the store or an advisory message used along with other identification to identify the customer at the POS during a redemption process. Further, in yet another embodiment, incentives may be targeted to specific customers based on a customer's purchase history (502) and transmitted to the consumers by e-mail using the customers' e-mail addresses stored in a consumer database (506). In other words, notification or indication of the availability of these incentives is transmitted to the customers in the form of Internet messages, for retrieval when the customers or consumers next access a web site associated with the system or check their e-mails. Finally, the incentive message informs a customer that one or more specific offers are available and can be received at a participating POS when the prerequisite products are purchased. Alternatively, subsequent to receiving an e-mail notification or an indication of an incentive offer, an image of a paper coupon may be transmitted to the customer's computer site and printed for later presentation at pre-selected POS (See abstract; page 9: 22-30; page 12: 23-25; page 13: 2-3; page 15: line 3-10; page 20: 2-8; page 20:16 to page 21: 30; figs 9 and 11-15).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

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